

REMARKS

In the present Application, Claims 12 and 21 have been cancelled, and Claims 1, 10 and 22 have been amended. As such, Claims 1-7, 10, 11, 13-20, and 22 are currently pending. The Examiner's objections and rejections are as follows:

(I) The Examiner did not enter the substitute specification as it allegedly contains material on pages 2 and 3 not in the original specification; and

(II) Claims 1-7 and 10-22 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Rees et al. 6,197,330 or 5,972,332.

Applicant believes the following amendments and remarks traverse the Examiner's objections and rejections.

I. Substitute Specification

The Examiner indicated that the previously submitted substitute specification would not be entered since it allegedly contains "added disclosure (pages 2 and 3) not in the original specification." (Office Action, pg 2). Applicant respectfully submits that the substitute specification was proper and therefore must legally be entered.

The Examiner, by pointing to pages 2 and 3 in the substitute specification, apparently believes that new paragraphs 7-10 were not in the original disclosure. Applicants disagree. New paragraphs 7-10 are simply the Originally Filed claims, placed into paragraph format. The text of the Original Claims has not been changed (i.e. it is repeated verbatim in the specification). Consequently, the Examiner is not even required to make a judgment call to determine if new paragraphs 7-10 are support by the Originally filed claims. As such, new paragraphs 7-10 are not "added disclosure" as alleged by the Examiner.

The law is very clear that Originally Filed claims form part of the specification. In particular, MPEP 608.01(I) "Original Claims" states:

"[i]n establishing a disclosure, applicant may rely not only on the description and drawing as filed, but also on the original claims if their content justifies it."

The case law is also very clear that the Original Claims form part of the specification (See, *Hyatt v. Boone*, 146 F.3d 1348, 1352 (Fed. Cir. 1998), stating "[t]he claims as filed are part of the specification", citing *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 938, (Fed. Cir.

1990); *In re Benno*, 768 F.2d 1340, 1346 (Fed. Cir. 1985); and *In re Frey*, 166 F.2d 572, 575 (CCPA 1948). Moreover, the Federal Circuit has specifically stated that an Applicant may amend the specification in light of the original claims without the allegation that disclosure has been added. In particular, the *In re Benno* Court stated:

"[W]here a patent application as filed contains a claim which specifically discloses something not disclosed in the descriptive part of the specification (claims being technically part of the "specification," 35 USC 112, 2d.), in which case the applicant may amend the specification without being charged with adding "new matter," within the meaning of § 132." *In re Benno*, 786 F.2d at 1346.

In light of the above, it is clear that the Applicant has the right to place the Original Claims into the text of specification. As such, Applicant requests that the substitute specification be entered. Also, to the extent the Examiner does not agree to enter the substitute specification, Applicant would like to request an interview on this issue to expedite the allowance of this application. The Examiner may call the undersigned at the number listed below.

II. The Claims Are Not Obvious

The Examiner rejected Claims 1-7 and 10-22 under 35 U.S.C. 103(a) as being unpatentable over Rees et al. (6,197,330 or 5,972,332). In particular, the Examiner states:

"Rees et al. disclose attaching cells to a solid support and putting the cell-containing solid support into an enclosure. The solid support, and enclosure can be the same as required by the present claims. It would have been a matter of obvious choice depending on individual preference and convenience to modify Rees et al. by first putting the support into the enclosure, and then introducing cells into the enclosure to attach to the cells to the support."

Office Action, pages 2-3. Applicants respectfully disagree with this rejection.

Nonetheless, for business reasons, in order to further the prosecution of the present Application, yet without acquiescing to the Examiner's rejection, while explicitly reserving the right to prosecute the original claims (or similar claims) in the future, the Applicant has amended certain claims. In particular, the Applicant has amended Claims 1 and 10 such that they recite step b) "treating solid support material with a hydroxide solution." Support for this amendment is found throughout the specification including, for example, the final paragraph on page four of the originally filed application (first full paragraph on page 6 of the substitute specification)

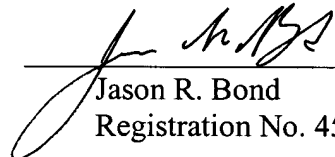
where the solid support is treated with sodium hydroxide such that the solid support has a higher avidity for the cells than the enclosure material.

The references cited by the Examiner do not teach treating the solid support material with a hydroxide solution. As such, the Examiner would not be able to establish a *prima facie* case of obviousness for the claims as amended.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that Applicant's claims should be passed to allowance. If a telephone interview would aid in the prosecution of this Application, Applicant encourages the Examiner to call the undersigned collect at 608-218-6900.

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